

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAKOB NIELSEN

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Appeal No. 2000-2245  
Application No. 08/661,686

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ON BRIEF

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Before HAIRSTON, KRASS, and RUGGIERO, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-3, 5-7, 9-14, 16-18, 20-27, 29-35, 37 and 38. Claims 4, 8, 15, 19, the only other pending claims, have been indicated by the examiner as being directed to allowable subject matter and are not on appeal.

The invention is directed to providing a method and apparatus for identifying and automatically deleting junk e-mail messages. An e-mail message delivered to one or more members of a group of trusted recipients may be classified as being junk e-mail by one or more of these recipients, in which case the presentation of the junk e-mail to other trusted members of the group who have not yet viewed the junk e-mail is prevented.

Representative independent claim 1 is reproduced as follows:

1. A computer controlled method for processing electronic mail (e-mail) comprising the steps of:

(a) automatically presenting an e-mail message to a first trusted recipient; said first trusted recipient being one of a plurality of trusted recipients;

(b) classifying said e-mail message as junk e-mail; and

(c) when said e-mail is classified as junk e-mail, automatically preventing presentation of said e-mail message to one or more of said plurality of trusted recipients.

The examiner relies on the following references:

Gross et al. (Gross)	5,283,856	Feb. 01, 1994
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"Making connections to the 'Net. [Connections] (company policies for employee Internet use)", MIDRANGE Systems, vol. 8, no. 2, p21(1). (Jan. 27, 1995).

Claims 1-3, 5-7, 9-14, 16-18, 20-27, 29-35, 37 and 38 stand rejected under 35

U.S.C. § 103 as unpatentable over Gross in view of Connections.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

### OPINION

It is the examiner's position, with respect to independent claim 1, that Gross discloses the claimed subject matter but for a censoring of e-mail by trusted recipients. The examiner relies on Connections for the teaching of censoring junk e-mail, or the prevention of presenting e-mail to others when such is classified by the censoring agent as junk. The examiner concludes that it would have been obvious to apply censoring to Gross "because of the taught risk of sex harassment charges against the censoring agency." Again, the examiner stresses that censoring is "exactly the process of having a member review contents to prevent presentation to other members and therefore is exactly what is claimed" [answer-page 4].

Gross discloses an event-driven rule-based messaging system and specifically mentions the application of the disclosed invention to an electronic messaging system [see, for example, column 1, lines 36-37 and column 2, lines 42-43]. Gross does disclose that e-mail is "screened" [column 1, line 37], a decision is made and an action is taken. Gross also discloses in the background section that the rules include conditions which describe values associated with attributes of a mail message, such as what the message is about [column 1, line 45]. A typical action may be to delete such e-mail

message [column 1, line 50].

Accordingly, Gross does disclose a method for processing e-mail which comprises the steps of automatically presenting an e-mail message to a “first trusted recipient” [anyone receiving the e-mail may be a “trusted recipient”], classifying the e-mail message [the message is screened and decisions made based on that screening and certain rules]. As the examiner explains, classification specifically as “junk e-mail” is relative and any action taken by Gross which deletes an e-mail may be considered a deletion because the recipient considered this e-mail to be “junk e-mail,” i.e., junk e-mail is in the eye of the beholder. When such e-mail is deleted, i.e., “classified as junk e-mail,” this automatically prevents presentation of such e-mail message to one or more of a plurality of recipients.

Thus, the examiner’s rationale is reasonable, to a point. However, each of the instant independent claims 1 and 12 requires that the first trusted recipient to whom the e-mail message is presented is but “one of a plurality of trusted recipients.” Thus, any one of the plurality of trusted recipients may decide that a certain message is “junk e-mail” and delete that message for the whole group, thus preventing any others in the group from seeing the message because it has already been deleted by one of the trusted plurality. While Gross may be considered as sending a message to a “first trusted recipient,” this “first trusted recipient” is also the *only* recipient that may decide

what action, e.g., delete, is to be taken because Gross neither discloses nor suggests that the trusted recipient is “one of a plurality of trusted recipients,” as claimed.

Additionally, since there is no more than a single possible trusted recipient disclosed by Gross, and that single trusted recipient must have the e-mail presented in order to decide whether it is to be deleted, there can be no “automatically preventing presentation of said e-mail message to one or more of said plurality of trusted recipients,” as required by each of the independent claims 1, 12, 23 and 31. This language cannot apply to the single possible trusted recipient in Gross because the single recipient must read the message before deciding to delete it. Thus, this single trusted recipient would not have been prevented from receiving the e-mail message and, since there are no others authorized to read the e-mail and decide what action to take in Gross, because there is no teaching of a “plurality of trusted recipients” in Gross, then a “presentation prevention mechanism configured to prevent presentation of an e-mail message to one or more of a plurality of trusted recipients,” as set forth in claim 23, cannot be met by Gross.

Connections is no help in providing for the deficiencies of Gross since Connections is merely an article describing the necessity of establishing policies by companies for providing guidelines regarding e-mail content in order to avoid legal liability. There is nothing therein that would provide a suggestion to the artisan to

provide for a plurality of trusted recipients in Gross or for the prevention of the presentation of e-mail messages to one or more of a plurality of trusted recipients, as required by instant claims 1, 12 and 23 and, by extension, to dependent claims 2-11, 13-22 and 24-27.

Accordingly, we will not sustain the rejection of claims 1-3, 5-7, 9-14, 16-18 and 20-27 under 35 U.S.C. § 103.

Turning now to independent claim 29, this claim does not require the plurality of trusted recipients or the prevention of presenting an e-mail message to one or more of the plurality of trusted recipients, as in claims 1, 12 and 23. This claim does require, however, a "junk mail report message" and appellant argues that this is not taught or suggested by Gross. Independent claims 31 and 37 contain similar limitations regarding a junk mail report message. The examiner's only rationale in this regard is that to the extent the claims "add limitations of generating lists and messages regarding the results of the processes, it is officially noticed that computing operations generally compile lists and messages of operating transactions for auditing and system monitoring purposes and are therefore obvious additions to the applied art. Further, as previously argued in the prior action, such documentation may be reasonably ascribed to the mail messages relating of [sic: to] such activity" [answer-pages 6-7].

Thus, the examiner cannot point to anything in Gross or Connections to suggest the claimed “junk mail report message” and relies solely on official notice that lists and messages are generally compiled. Even if lists and messages were known to have been “generally compiled,” the examiner has not shown how or why it would have been obvious to provide, in the Gross system, a notification mechanism configured to receive a “junk mail report message” containing information about an e-mail message classified as junk e-mail by a trusted group recipient or a presentation prevention mechanism configured to prevent presentation of an e-mail message to one or more of a plurality of trusted recipients, wherein the presentation prevention mechanism includes a junk e-mail reporting mechanism configured to send a junk e-mail report message to a trusted group server.

The examiner’s conclusory statements that generally compiled lists and messages of operating transactions for monitoring purposes “may be reasonably ascribed to the mail messages relating of [sic] such activity” does not adequately address the issue of motivation to combine the Gross and Connections references. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. The examiner must not only make requisite findings, based on the evidence of record, but must also explain the reasoning by which

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the findings are deemed to support the conclusion of obviousness. See In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

Since, in our view, the examiner has failed to establish a prima facie case of obviousness by providing adequate evidence of the requisite suggestions in the prior art and/or of the requisite motivation to combine the applied references, we will not sustain the rejection of claims 1-3, 5-7, 9-14, 16-18, 20-27, 29-35, 37 and 38 under 35 U.S.C. § 103.

The examiner's decision is reversed.

REVERSED

KENNETH W. HAIRSTON  
Administrative Patent Judge

ERROL A. KRASS  
Administrative Patent Judge

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JOSEPH F. RUGGIERO  
Administrative Patent Judge

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